

establish that searching both inventions constitutes an undue burden to the Patent Office. Moreover, Applicants urge that the Restriction Requirement is contrary to public policy. Accordingly, Applicants submit that the Restriction Requirement is improper and should be withdrawn.

It is believed that no fee is required for the consideration of the paper. If, however a fee is required, the Assistant Commissioner is authorized to charge such fee, or credit any overpayment, to Deposit Account No. 50-0320.

The MPEP lists two criteria for a proper restriction requirement. First, the invention must be independent or distinct. MPEP § 803. Second, searching the additional invention must constitute an undue burden on the examiner if restriction is not required. *Id.* The MPEP directs the examiner to search and examine an entire application “[i]f the search and examination of an entire application can be made without serious burden, ... even though it includes claims to distinct or independent inventions.” *Id.*

Applicants urge that the Restriction Requirement does not meet the second of these criteria as the search for both inventions overlaps. As indicated in the Office Action the inventions of Group I and Group II are related as product and process of preparing the product and to a method of using the product. Applicants urged that while the inventions are distinct, the two inventions are so closely related that one would search both areas in order to have a complete search

Further, it is respectfully urged that restricting the claims in the manner suggested in the Restriction Requirement constitutes an undue burden to Applicants as well as the public. The cost of prosecuting and maintaining two patents is unreasonable in view of the fact that the two groups are so closely related. Further, the public is inconvenienced as they will not know

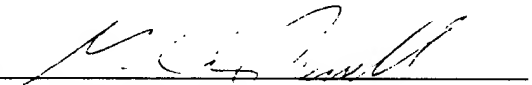
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whether or not Applicants will file a divisional application to the remaining subject matter. Accordingly, the public will not know if they can practice the remaining invention without infringing future patent application.

Accordingly, in view of the foregoing, reconsideration and modification of this restriction requirement is requested and an early action on the merits is earnestly solicited.

Respectfully submitted,

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